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10/056,424	01/24/2002	Kenji Mizutani	MTS-3301US	8062

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EXAMINER
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ALBERTALLI, BRIAN LOUIS

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,424

Applicant(s)

MIZUTANI ET AL.

Examiner

Brian L. Albertalli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to the claims have been entered. Claims 1-6 are currently amended.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

3. The amendments to the abstract and title overcome the objections made in the previous Office Action. The objections to the abstract and title are withdrawn.

### ***Claim Objections***

4. The amendments to claim 3 overcome the objections made in the previous Office Action. The objection to claim 3 is withdrawn.
5. However, as amended, claim 5 is objected to for lacking antecedent basis. Claim 5, line 2 includes the limitation that "said specified part of said example is replaced". Parent claim 1 only indicates that the example is specified (lines 1-2), not a part of the example. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7 and 8 are drawn to a "program" *per se* as recited in the preamble and as such are non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and

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other claimed elements of a computer, which permit the computer program's functionality to be realized.

In this case claims 7 and 8 are directed to "[a] program for causing a computer to function..." and thus are clearly non-statutory. However, dependent claims 9 and 10 are directed to the program embedded on a computer readable medium and thus are statutory. Therefore, to overcome the non-statutory subject matter rejection of claims 7 and 8, both claims should be amended to read –A program embodied on a computer readable medium for causing a computer...--, thereby incorporating dependent claims 9 and 10, respectively, and claims 9 and 10 should be cancelled.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-10 rejected under 35 U.S.C. 102(e) as being anticipated by Koizumi et al. (U.S. Patent 6,917,920).

In regard to claim 1 and 6, Koizumi et al. disclose a speech converting device (Fig. 1) and method (Fig. 3) comprising:

speech inputting means (step) of inputting speech of a first language  
(microphone 106, column 5, lines 10-11);

speech recognizing means (step) of recognizing said input speech (Fig. 2,  
hardware configuration of the transcription device, spoken word recognition program  
262);

first extracting/displaying means (step) of extracting and displaying one or plural  
word strings of said first language, said word strings corresponding to a result of said  
speech recognition (a user orally inputs a word and a plurality of word candidates  
corresponding to the orally input word are displayed, column 6, lines 55-67, see also  
Fig. 8)

conversion object selecting means (step) of, from said displayed word strings,  
selecting an example which is expected to become an object of conversion to a second  
language (the user selects the intended word, which is used to retrieve sentences that  
will be translated to a second language, column 7, lines 1-4 and lines 13-17 as well as  
column 8, lines 30-32);

second extracting/displaying means (step) of, when said selected example is  
specified, extracting and displaying candidates of a class which corresponds to contents  
of said selected example (Sentences are retrieved which have category codes that  
correspond with the content of the selected word. For example, when the term "bank" is  
selected, this term is associated with category codes such as 'place' and 'organization'  
which are words of high abstractness. Sentences which have keywords that are

specific subjects of the category are selected and displayed for the user, see column 7, lines 39-56);

candidate selecting means (step) of selecting words of the same class out of said displayed candidates (user selects one of the displayed sentences, column 8, lines 38-30); and

converting means (step) of determining said object of conversion to said second language on the basis of said selected example and said words of the same class, and of converting said determined conversion object to a speech language of said second language (the selected sentence is translated, column 8, lines 30-32).

In regard to claim 2, Koizumi et al. disclose said first extracting/displaying means has a displaying section comprising a display screen which displays said plural word strings that are objects of said selection (word candidate display screen, see Fig. 8, column 6, lines 62-63, and

said selected word in respective predetermined regions, and said second extracting/displaying means overlappingly displays said candidates of a class in a partial region of said display screen in a window form (retrieved sentences, see Fig. 9, column 7, lines 57-59).

In regard to claim 3, Koizumi et al. disclose when said selected example is displayed on said display screen, said first extracting/displaying means additionally displays also information indicating that candidates of the corresponding class can be

displayed, with respect to a part of said example (an asterisk "\*" at the head of each word candidate indicates the word candidate is a keyword that can be used to retrieve sentences with corresponding category codes, column 7, lines 10-12).

In regard to claim 4, Koizumi et al. disclose said speech converting device further comprises screen display specifying means of specifying said part of said example on said display screen, said additional information being displayed with respect to said part of said example (the user scrolls through the word candidates on the screen, column 7, lines 1-4, see also box on display screen specifying the first word in Fig. 8).

In regard to claim 5, Koizumi et al. disclose said converting means determines a result in which said specified part of said example is replaced with a class of said selected candidate, as said conversion object (sentences corresponding to a category code of the selected keyword, which do not necessarily contain the selected keyword, are selected for translation, which replaces the keyword on the display, column 7, lines 39-56, column 8, lines 30-32, and column 11, lines 20-22).

In regard to claims 7-10, Koizumi et al. disclose a program embedded on a computer readable medium to function according any one of claims 1 to 5 as well as claim 6 (column 11, line 62 to column 12, line 16).



***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Doi et al. (U.S. Patent 4,787,038) disclose a system that displays possible translation results of a same class. Kugimiya et al. (U.S. Patent 5,005,127) disclose a system that only translated a selected portion of an example in a first language.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L. Albertalli whose telephone number is (571) 272-7616. The examiner can normally be reached on Mon - Fri, 8:00 AM - 5:30 PM, every second Fri off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BLA 7/12/05

  
SUSAN MCFADDEN  
PRIMARY EXAMINER